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Serial No. 09/682,583

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First Named Inventor: David N. Brotherston

Examiner: Akintola, Olabode

Title: APPARATUS AND METHOD
FOR PROVIDING PRODUCTS AND
SERVICES IN A TRANSPORT
VEHICLE USING A NETWORK OF
COMPUTERS

Attorney Docket No. P3S2002336US

June 19, 2009

Gifu, Japan

REPLY BRIEF UNDER 37 CFR § 41.41(a)(1)

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Commissioner for Patents
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Honorable Commissioner:

This Reply Brief is filed responsive to the Examiner's Answer dated April 28, 2009. The due date is two months from the mailing date of the Examiner's Answer and this Reply Brief is being timely filed within that period.

ARGUMENT

There are a number of errors and omissions in the Examiner's Answer, starting from the first page of the document. Specifically, the first page of the Examiner's Answer states that it "is in response to the appeal brief filed December 8, 2008". This is incorrect and should be in response to the Appeal Brief filed February 11, 2009, which is the latest filed appeal brief. The remaining errors in the Examiner's Answer are discussed individually in the

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following paragraphs, in which for convenient reference the headings are identical to the headings to those used in the Examiner's Answer.

#1: Reopening of Prosecution after Final Rejection.

The Examiner's explanation is an admission that that no new ground of rejection was present in the Office Action dated August 11, 2008. The Examiner's authorization for reopening prosecution in this situation was pursuant to MPEP 1207.4. According to MPEP 1207.04, "[t]he examiner may, with approval from the supervisory patent examiner, reopen prosecution *to enter a new ground of rejection* after appellant's brief or reply brief has been filed" (emphasis added).

The Examiner has not cited any legal authority or MPEP provision authorizing the reopening of prosecution after the filing of an Appeal Brief merely upon "due consultation with the Appeal Brief Specialist". The Examiner's improper reopening of prosecution delayed the prosecution of an application that has already been pending for more than seven years and for which it took the US Patent Office more than five years from the filing date of this application to issue a first office action (Office Action dated November 3, 2006).

The Office Action of August 11, 2008 reopening prosecution is exemplary of failure to comply with Section 707.07(g) of the MPEP, which states that "[p]iecemeal examination should be avoided as much as possible." As uncontested by the Examiner, the Office Action dated August 11, 2008 was a duplicate of the Final Office Action dated January 10, 2008, except for the portion of the Final Office Action entitled "Response to Arguments".

The Examiner was in possession of the Appeal Brief dated June 10, 2008 and admits to at least reading the portion discussing due process. Why did the Office Action reopening prosecution not address any points in the foregoing Appeal Brief, such as ignoring claim recitations? The Office Action reopening prosecution could have finally provided a copy of a

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reference supporting his rejection of Claim 9 (discussed *infra*), in which said supporting reference had been requested nearly two years ago.

The Examiner instead surprises the applicant with new, unsupported legal theories for the first time in the Examiner's Answer as to why he does not need to consider all claim recitations and finally provides a reference to support his rejection of Claim 9. These issues could have been addressed in the most recent Office Action, rather than simply duplicating the Final Office Action, and permitting resolution during prosecution and saving the Board much time. The Examiner's behavior is the very definition of piecemeal examination.

Section 707.02 of the MPEP provides that (emphasis in original):

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent *Office< action with a view to finally concluding its prosecution.

This section of the MPEP further provides (emphasis in original):

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort >should be< made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

The Office Action reopening prosecution was the *sixth* office action in the tortured history of this application. As noted above the application has been pending for more than seven years. Clearly the Office Action reopening prosecution, a cut-and-paste of the Final Office Action, including typographical errors, was in no way compliant with the provisions of MPEP 707.02 and was not intended to terminate prosecution of the application.

#2: Rejection of claims 1-3 under 35 U.S.C. § 103(a) over Berry in view of Ross.

Upon consideration of Appellant's arguments that the Examiner ignored claim recitations, such as the recitation of "*on the transport vehicle*" in subparagraph i) of paragraph (c) in Claim 1 (emphasis added), the Examiner realizes his rejections are unsupportable. The policy of compact prosecution as set forth in MPEP 2164.04 dictates that

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the Examiner should now withdraw these rejections. This is especially true after the issuance of six Office Actions and three new grounds of rejections.

Rather than withdrawing the rejections and saving the Board much time, the Examiner presents new, unsupported legal theories as to why he may ignore claim recitations. This is set forth in the Examiner's Answer at Page 14 (emphasis in original):

[T]he various tasks (i.e., c(i)-c(iii)) that are *operably* performed by the software on the external computer are considered as intended use of the software; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claims.

The Examiner has not cited any authority that permits claim recitations to be ignored simply because "operably" is recited or the root word thereof. To the contrary, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In particular, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." In re Oichia, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." CMFT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)).

Even if the "various tasks... performed by the software on the external computer are considered as intended use" as asserted by the Examiner, the recitation of the intended use of the claimed invention" nevertheless *does* "result in a structural difference between the claimed invention and the prior art". Specifically, software installed in a computer encodes recording media in the computer with program instruction code that performs the "various tasks" when executed by the computer. The encoded recording media is structurally different from other such unencoded recording media due, inter alia, to the presence of a different bit pattern in the recording media as a result of the encoding. Moreover, there is substantial legal

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authority that such encoded recording media is different, beginning with the case of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

More particularly, recording media encoded with different software is considered under Federal court precedents to be different from one another despite the software being merely “operably” performed by a computer. Id. Otherwise, virtually all Beauregard-type claims would be obvious over prior art. In addition, the prior art structure cited by the Examiner is NOT “capable of performing the intended use” because the prior art structure does not have the recited software and therefore could not achieve the results of the claimed arrangement. Thus, even under the standard set forth by the Examiner, Claim 1 distinguishes over the cited prior art.

Finally, the Examiner asserts that “Ross teaches a path for communicating delivery status information between the on board [sic] computer and the external computer.” This is presumably a reference to the previous Final Office Action at Page 11, where the Examiner asserts that “Ross teaches a path for communicating *delivery status information* between the controller 10 and central controller 22” (emphasis in original). The Examiner parenthetically concludes that this meets the recitation of “*acquiring information to determine the available services provided*” (Final Office Action, Page 11, emphasis in original). Assuming for the purposes of argument that this is true, Claim 1 does not recite status and once again, the Examiner ignores the recitation of “*on the transport vehicle*” in subparagraph i) of paragraph (c) in Claim 1 (emphasis added).

As explained in the Appeal Brief, the word status is used at many locations in the specification and even appears in the drawing figures. The Applicant was therefore fully cognizant and versed in the usage of the word status at the time of filing of the application. If the Applicant had intended to recite status in Claim 1, it would have been done, for example by reciting “acquiring information to determine the *status* of available services provided on

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the transport vehicle”. However, that was not what was intended, which is why status is not recited in Claim 1.

While pending claims in examination are given their broadest reasonable interpretation, that interpretation must be consistent with the specification. MPEP 2111; Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc). Equating status with service as the Examiner has done is inconsistent with the present specification.

As explained in the Appeal Brief, the specification and drawings distinguish between status and service and do not equate the two. “[C]ommunicating delivery status” is not a service. Delivery status is information indicating whether the service has been completed, i.e., delivery, and not information indicating the “available services provided on the transport vehicle” as recited in Claim 1. Hence, the Examiner’s construction of the recitation of service in Claim 1 as equivalent to status is inconsistent with the specification.

Claims 2 and 3 each depend from Claim 1 and therefore distinguish over the cited art for at least the same reasons as Claim 1. With respect to Claims 2 and 3, the Examiner ignores recitations thereof. In Claim 2, the Examiner ignores the recitation that “the onboard computer software includes logic routines adapted for”. In Claim 3, the Examiner ignores the recitation of “logic routines”. Accordingly, Claims 2 and 3 distinguish over the cited art in addition to the reasons stated for Claim 1 and reversal of the rejections of Claims 2 and 3 is respectfully requested.

#3: Rejection of claims 4 and 14 under 35 U.S.C. § 103(a) over Berry in view of Ross and further in view of Camaisa/Hall.

The Examiner once again asserts his unsupported legal theory as to why he may ignore claim recitations because the word operable is recited in Claims 4 and 14. As discussed above, the Examiner has not cited any authority that permits claim recitations to be

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ignored simply because “operably” is recited or the root word thereof. To the contrary, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Even if the “further tasks... performed by the software on the external computer are considered as intended use” as asserted by the Examiner, the recitation of the intended use of the claimed invention nevertheless *does* “result in a structural difference between the claimed invention and the prior art”. As discussed above, software installed in a computer encodes recording media in the computer with program instruction code that performs the “further tasks” when executed by the computer. The encoded recording media is structurally different from other such unencoded recording media due, inter alia, to the presence of a different bit pattern in the recording media as a result of the encoding. Moreover, there is substantial legal authority that such encoded recording media is different, beginning with the case of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

The Examiner does not dispute his failure to cite any portions of the prior art that recite “accepting service orders prior to boarding” as recited in each of Claims 4 and 14. Nor has he made a citation to any mention or suggestion of “external computer software” that “associates each service order with a vehicle departure and makes the information obtainable by the onboard computer” as also recited in each of Claims 4 and 14. Instead, the Examiner merely responds on Page 15 of the Examiner’s Answer that the cited art teaches certain “concepts”, which the Examiner concludes to render Claims 4 and 14 obvious.

The Examiner is under evidently under the mistaken impression that the invention can be reduced down to certain “concepts” and that he need only cite prior art suggesting these concepts, rather than the express claim recitations. As provided in Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987), it is improper to distill an invention down to a “concept” as the

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Examiner has done. In Bausch & Lomb, the district court improperly focused on the “concept” of the invention and ignored express claim recitations, just as the Examiner has been ignoring express claim recitations in this situation.

Claim 4 depends from Claim 1 and therefore distinguishes over the cited prior art in addition to the reasons discussed for Claim 1. Claim 14 depends from Claim 13, which in turn depends from independent Claim 7. Claim 7 is discussed in detail below, and as Claim 14 depends indirectly from Claim 7, Claim 14 distinguishes over the cited prior art in addition to the reasons discussed for Claim 7.

#4: Rejection of claim 5 under 35 U.S.C. § 103(a) Over Berry in view of Ross and further in view of Roden

The Examiner once again asserts his unsupported legal theory as to why he may ignore claim recitations because the word operable is recited in Claim 5. As discussed above, the Examiner has not cited any authority that permits claim recitations to be ignored simply because “operably” is recited or the root word thereof. To the contrary, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Upon this basis, the Examiner ignores the last phrase in Claim 5 reciting that the external computer software “associates each current service order with a vehicle departure and makes the information obtainable by the onboard computer”. Even if the foregoing recitation performed by the software on the external computer is “considered as intended use” as asserted by the Examiner, the recitation of the intended use of the claimed invention nevertheless *does* “result in a structural difference between the claimed invention and the prior art”.

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As discussed earlier, software installed in a computer encodes recording media in the computer with program instruction code that performs the recited tasks when executed by the computer. The encoded recording media is structurally different from other such unencoded recording media due, inter alia, to the presence of a different bit pattern in the recording media as a result of the encoding. Moreover, there is substantial legal authority that such encoded recording media is patentably different, beginning with the case of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

Finally, the Examiner once again attempts to focus on a "concept" in the claimed invention contrary to the decision Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987). As provided in Bausch & Lomb, it is improper to focus on the "concept" of the invention and ignore express claim recitations, as the Examiner has done for Claim 5.

Claim 5 depends from Claim 1 and therefore distinguishes over the cited prior art in addition to the reasons discussed for Claim 1. Accordingly, reversal of the rejection of Claim 5 is respectfully requested.

#5: Rejection of claim 6 under 35 U.S.C. § 103(a) over Berry in view of Ross in view of Bravman

The Examiner ignores the contentions that the rejection of Claim 6 failed to provide "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006) and that the rejection was based on hindsight.

Instead the Examiner responds only to the argument there is no mention of a terminal at Col. 2, lines 49-62 of Bravman. In particular, the Examiner responds with a cryptic statement that "Bravman teaches the *concept* as articulated in the rejection" (emphasis added).

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Col. 2, lines 49-62 of Bravman are reproduced below. As can be seen there is no mention of a terminal in the cited portion of Bravman:

The inventory storing and managing system further includes means for transmitting an order, derived from the reorder message, to an origination point for the transportation of the at least one inventory item; means for generating a two-dimensional bar code symbol label for application to the inventory item, containing item destination information identifying a destination point; means for transporting the at least one inventory item from the origination point to a redistribution point; a bar code reader at the redistribution point, including decoding means for decoding the two-dimensional bar code symbol label relating to the item destination information; and means for transporting the at least one inventory item from the redistribution point to the destination point.

Neither has the Examiner provided a specific citation to one of the twenty-five drawing sheets of Bravman showing a terminal for a transport vehicle. Moreover, as discussed previously, it is improper to focus on the "concept" of the invention and ignore express claim recitations. Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987).

As Claim 6 depends from Claim 1, it distinguishes over the cited art in addition to the reasons discussed for Claim 1. Hence, reversal of the rejection of Claim 6 is requested.

#6: Rejection of claim 25 under 35 USC § 103(a) over Berry in view of Ross in view of Tracy

In response to the contention that the Examiner's reasoning for the rejection is conclusory, not articulated, and therefore fails to comply with the standard set forth in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), and is based on hind-sight, the Examiner merely responds that "KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness."

The Examiner is making a straw-man argument. There is no argument presented in the Appeal Brief "that a specific teaching, suggestion, or motivation is required to support a

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finding of obviousness.” Appellant was aware of the US Supreme Court decision in KSR International Co. v. Teleflex Inc., at the time the Appeal Brief was prepared and cites the decision multiple times. In particular, the Appeal Brief cites the portion of the US Supreme Court decision at 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006) stating that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

The Examiner is equating “a specific teaching, suggestion, or motivation” with the requirement for “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In effect, the Examiner has admitted that his rejection of Claim 25 is conclusory and not articulated contrary to a requirement set forth by the US Supreme Court for supporting a legal conclusion of obviousness.

#7: Rejection of claims 7 and 12 under 35 U.S.C. § 103(a) over Berry in view of Rondeau

The Examiner once again asserts his unsupported legal theory as to why he may ignore claim recitations, but this time because “adapted for” is recited instead of “operable”. Notwithstanding, the Examiner has not cited any authority that permits claim recitations to be ignored simply because “adapted for” is recited. To the contrary, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Upon the basis of this unsupported legal theory, the Examiner ignores the recitation in Claim 7 of “providing menu options adapted for specific customer preferences that vary based on pre-selected products and services and historical preference”. Even if the foregoing recitation performed by the software on the computer is “considered as intended use” as

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asserted by the Examiner, the recitation of the intended use of the claimed invention nevertheless *does* “result in a structural difference between the claimed invention and the prior art”.

As discussed earlier, software in a computer encodes recording media in the computer with program instruction code that performs the recited tasks when executed by the computer. The encoded recording media is structurally different from other such unencoded recording media due, inter alia, to the presence of a different bit pattern in the recording media as a result of the encoding. Moreover, there is substantial legal authority that such encoded recording media is different, beginning with the case of In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

The Examiner concludes with the assertion that “Rondeau teaches customizing customer menu [sic] based on historical usage.” This is presumably a reference to the Final Action at Page 11, where the Examiner asserted that “Rondeau explicitly teaches the *concept* of using customer historical usage or profile to customize [a] menu screen presented to the customer” (emphasis added).

Focusing on a “concept” in the claimed invention is contrary to the decision in Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987). As provided in Bausch & Lomb, it is improper to focus on the “concept” of the invention and ignore express claim recitations as the Examiner is doing for Claim 7.

Claim 12 depends from Claim 7 and further recites that “the handheld or onboard computers include hardware and software enabling reading of cards for facilitation of onboard cash-less transactions.” The Examiner completely ignores Claim 12 and fails to cite to any portions of Berry or Rondeau meeting the recitations of Claim 12.

Accordingly, the Examiner has failed to provide “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” for Claim 12. KSR

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International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). Specifically, the Examiner's articulation is not clear as there is no articulation of any reasons as to how the cited prior art renders Claim 12 obvious. Accordingly, reversal of the rejection of Claim 12 is respectfully requested.

#8: Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) over Berry in view of Rondeau

The Examiner repeats his straw-man argument that "KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness." There is no argument presented in the Appeal Brief "that a specific teaching, suggestion, or motivation is required to support a finding of obviousness." The Examiner is equating "a specific teaching, suggestion, or motivation" with the requirement for "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" as set forth in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). The Examiner has essentially admitted that his rejections of Claims 10 and 11 are conclusory and not articulated and therefore his rejections should be reversed.

#9: Rejection of claim 13 under 35 U.S.C. § 103(a) over Berry in view of Rondeau and further in view of Ross

The Examiner relies upon his previous arguments presented above for Claims 1 and 7. Appellant likewise relies upon the discussion above showing the rejections are improper and should be reversed.

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#10: Rejection of claim 14 under 35 U.S.C. § 103(a) over Berry in view of Rondeau and in view of Ross, and further in view of Camaisa/Hall

The Examiner relies upon his previous arguments presented above for Claims 4 and 13. Appellant likewise relies upon the discussion above showing the rejections are improper and should be reversed.

#11: Rejection of Claim 15 under 35 U.S.C. § 103(a) over Berry in view of Rondeau in view of Ross, and further in view of Leuca

The Examiner asserts that Leuca teaches at Col. 2, lines 7-12 providing "Internet access to a connection *at a passenger seat location* corresponding to the service order" as recited in Claim 15 (emphasis added). Col. 2, lines 7-12 of Leuca are reproduced below:

The present invention provides a method and a communications system that provides an integrated voice/data service to airborne passengers that can mix various data services, such as accessing the Internet or placing a voice call, and thereby efficiently utilizing the air channels available to airborne passengers.

As can be seen there is no mention in the cited portion of Leuca meeting the above quoted recitation from Claim 15. In addition, Claim 15 depends from Claim 13, which in turn depends from Claim 7. Accordingly, Claim 15 is nonobvious over the cited art in addition to the reasons previously discussed for each of Claims 7 and 13. Thus, reversal of the rejection of Claim 15 is respectfully requested.

#12: Rejection of claims 8 and 9 under 35 U.S.C. § 103(a) over Berry in view of Bezos

According to the Examiner's Answer, the prior art cited against Claim 8 was introduced "to show that the *concept* of having a portable personal information processing apparatus carried on by users is old and well known" (emphasis added). Once again, the

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Examiner attempts to focus on a “concept” in the claimed invention contrary to the decision Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987). As provided in Bausch & Lomb, it is improper to focus on the “concept” of the invention and ignore express claim recitations, as the Examiner is doing for Claim 8.

Claim 8 does not merely recite “portable personal information processing apparatus carried on by users”. In pertinent part, the claim recites:

[S]oftware, which when operated on the onboard computer and electronic devices causes the onboard computer to perform tasks comprising accepting service orders entered via the electronic devices by vehicle personnel or passengers and making the service orders accessible to vehicle personnel, wherein the electronic devices include passenger supplied personal information processing apparatus carried on by passengers.

Assuming for the purposes of argument that the cited art shows it is old and well known to have “a portable personal information processing apparatus carried on by users”, the Examiner has not shown it is old for such software as recited in the claim. Specifically, software that causes an “onboard computer to perform tasks comprising accepting service orders entered via the electronic devices by vehicle personnel or passengers and making the service orders accessible to vehicle personnel”. These express recitations are being ignored because the Examiner has improperly distilled the invention down to a concept.

At the time the invention was filed, it would not have been predictable based on the cited art to have modified Berry to include the teachings of Bezos. As can be seen from the abstract, Bezos teaches a system for using a credit card over an unsecured network to submit an order to “a remote merchant location (32) from a customer’s location (10).” In particular, the order is transmitted over the Internet to the remote merchant location (32), but includes only a subset of the credit card number to which the order is to be charged (Bezoz, Abstract). The customer thereafter telephones the remote merchant location and provides the complete

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credit card number (Bezos, Abstract). Allowing passengers to connect their own personal computers to the system as taught in Bezos would introduce vulnerabilities creating an unsecure network.

Claim 9 depends from Claim 8 and further recites “wireless communication between the passenger supplied personal information processing apparatus carried on by passengers and the *onboard* computer” (emphasis added). While it may be well known for a PDA to use wireless connectivity with ground-based devices, it is not well known for such communication between “an onboard computer transported with the vehicle” as recited in Claim 1 from which Claim 9 depends via Claim 8, and “passenger supplied personal information processing apparatus carried on by passengers” as also recited in Claim 8.

This is evidenced by the patent that the Examiner alleges to show that the additional recitations of Claim 9 are well known. In particular, the Examiner cites Col. 1, lines 33-66 of US Patent No. 5,526,481 to Park et al, stating that “PDAs are wireless, hand-held electronic devices that may be connected to a desktop personal computer (PC) or other PDAs via an infrared link”.

As can be seen there is no showing that it is common to use such PDAs to connect wirelessly to “an onboard computer transported with the vehicle” as recited in Claim 1 from which Claim 9 depends via Claim 8, and “passenger supplied personal information processing apparatus carried on by passengers” as also recited in Claim 8. Moreover, it would not work in the claimed arrangement as the cited portion thereof teaches an infrared link, which only works for direct line of sight over very short distances. In a transport vehicle, there would likely be no passengers at locations capable of using an infrared link to connect to the recited “onboard computer transported with the vehicle”.

If this technology was indeed well known as of the effective filing date of the present application, why has it taken the Examiner nearly two years to provide a supporting

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reference? Applicant timely traversed the rejection of Claim 9 pursuant to MPEP 2144.03 in an Amendment dated June 20, 2007 (6/20/2007 Amendment, Page 14, line 22 to Page 17, line 2). After approximately two years, Parks et al. is presumably the best reference that the Examiner could locate, which is a reference teaching infrared links that would not work in the claimed invention. The reference cited by the Examiner and the length of time that it took the Examiner to locate the reference is evidence supporting that the technology was not well known as of the US effective filing date of the present application.

Finally, Claim 9 depends from Claim 8 and is therefore nonobvious over the cited prior art in addition to the reasons discussed for Claim 8. Accordingly, reversal of the rejections of Claims 8 and 9 is respectively requested.

#13: Rejection of claims 16-24 under 35 U.S.C. § 103(a) over Berry in view of Ross in view of Camaisa in view of Roden in view of Rondeau and in view of Weber

The Examiner admits that he ignored the recitation in Claim 16 of “providing menu options adapted for specific customer preferences that vary based on *pre-selected products and services and historical preference*” (emphasis added). To support his rejection he relies upon his arguments presented for Claim 7. As discussed previously, there are several reasons why his arguments are flawed, such as he applies a novel legal theory without citation to any authority, improperly distills the invention down to a concept, and even under this unsupported legal theory, the recited software renders recording media in the computer structurally different due to the encoded bit pattern, and thus, the foregoing recitations cannot be ignored.

The Examiner further implies that it is legally sufficient “to conclude that a claim is obvious just because each feature of the claim can be independently shown in cited prior art” based upon KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007).

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According to the Examiner "KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness."

As discussed previously, the Examiner incorrectly equates "a specific teaching, suggestion, or motivation" with the requirement for "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" as set forth in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). It is *NOT* legally sufficient "to conclude that a claim is obvious just because each feature of the claim can be independently shown in cited prior art". According to the US Supreme Court in KSR International Co. v. Teleflex Inc., there must be at least "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness", rather than a mere showing that "each feature of the claim can be independently shown in cited prior art".

In addition, the Examiner asserts with respect to Claims 16-24 that "Appellant did not identify any limitation" apart from the recitation of Claim 7 that the Examiner has not already addressed above. This is incorrect. Additional claim recitations were identified that had not been addressed previously in the Examiner's Answer. For example, in Claim 16 the recitation was identified of "accessing database information pertaining to vehicle departure, destination, past service[s] orders, and inventory information".

This is a recitation that the Examiner concedes to not be taught by Berry, Ross, Camaisa, Rondeau, and Roden (present Office Action, Pages 10, 11 and 13; Final Office Action, Pages 9, 10 and 12). Due to this shortcoming, the Examiner cites Weber, which is directed to a system for radio transmission of real-time airline flight information (Weber, Title). In particular, the system gathers flight information, converts it to an audio signal and transmits it for reception by an airport visitor's automobile via radio frequencies (Weber, Col. 2, lines 19-23). With respect to Weber, the patent is directed to a system for radio transmission of real-time airline flight information (Weber, Title). More particularly, the

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system gathers flight information, converts it to an audio signal and transmits it for reception by an airport visitor's automobile via radio frequencies (Weber, Col. 2, lines 19-23).

Accordingly, "the airport visitor has the information needed to determine whether they need to go to either take or meet a flight" (Weber, Col. 2, lines 27-29).

According to the US Supreme Court, KSR International Co. v. Teleflex Inc., at 1396 (2007), "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way that the new claimed invention does." Id. No such reason has been identified by the Examiner. As noted above, Weber is directed to providing real-time airline flight information, which is not useful in the claimed invention. The claimed invention is directed to a system for fulfilling service orders on a transport vehicle, which requires positioning inventory in advance, i.e., not based upon information in real-time.

More particularly, the Examiner has not provided a reason why a person of ordinary skill in the art would have been prompted to combine a portion of a reference directed to providing real-time information with another reference directed to past service information and inventory information upon other than the present application, which is improper hindsight reasoning.

The Examiner concedes that hindsight reasoning is improper if it "include[s] knowledge gleaned only from the applicant's disclosure". The Examiner has not cited to any teachings in the prior art suggesting or disclosing how Weber, as directed to a system for radio transmission of real-time airline flight information, would be useful for fulfilling service orders on a transport vehicle as in the claimed invention, which requires positioning inventory in advance, i.e., not based upon real-time airline flight information. Accordingly, the Examiner's conclusion of obviousness "include[s] knowledge gleaned only from the applicant's disclosure" and is therefore improper. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

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With respect to Claim 16, the Examiner continues to neglect to provide any explanation as to why Camaisa is cited in the rejection of Claim 16. Specifically, the present Office Action has not identified where in Camaisa teachings are located disclosing recitations of Claim 16. As noted earlier, Section 2142 of the MPEP provides that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness” (emphasis in original). For the foregoing reasons, reversal of the rejection of Claim 16 is respectfully requested.

Finally, the Examiner ignores the arguments in the Appeal Brief concerning Claims 17-24. For example, Claim 17 depends from Claim 16 and further recites that “the external computer accepts service orders via communication with other computers through which service orders are entered.” The Examiner does not identify any portions of the cited art teaching these further recitations.

In another example, the Examiner fails to provide any explanation as to why Claim 23 is obvious over Berry, Ross, Camaisa, Roden, Rondeau and Weber as asserted on Page 10 of the Office Action. This is a clear failure to provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as required by KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). Accordingly, reversal of the rejections of Claims 16-24 is respectfully requested.

CONCLUSION

The Examiner has shifted his basis for the rejection of each of the independent claims in the application. His position in the Final Office Action and the Office Action reopening prosecution was that the cited art combinations met all of the recitations of each of the independent claims. He concedes that he ignored claim recitations in each of the independent

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claims, but now asserts he is nevertheless entitled to ignore these recitations as “intended use” based upon a legal theory for which he provides no citation to any authority.

The standard set forth by the Examiner is presumably quoted from somewhere, most likely, at least partially from the MPEP. As stated in the forward to the MPEP, the Manual “outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application”. However, as stated in the following sentence, “[t]he Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations.” In that regard, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As the Examiner has not provided any citation to binding legal authority, the Board is urged to disregard the Examiner’s unsupported legal theory and reverse all of the rejections.

Whether or not any authority for the Examiner’s legal theory can be cited, many reasons for reversing the Examiner’s rejections have been provided even in the presence of such a theory.

The discussion above shows that recitations in each of the independent claims were improperly ignored based upon the legal theory as set forth by the Examiner. Specifically, recited software renders recording media in the computer structurally different due to the encoded bit pattern, and thus, the foregoing recitations cannot be ignored even under the unsupported standard asserted by the Examiner.

In addition to ignoring claim recitations, the following have also been presented as reasons for reversing the Examiner’s rejections. With respect to Claim 1, for instance, the Examiner equates “status” with “service”, which is inconsistent with the specification and therefore improper under Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc).

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Concerning the other independent claims, the Examiner repeatedly distills the invention down to concepts and focuses on these concepts rather than the express claim recitations contrary to the decision in Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987). Regarding Claim 5 for example, which depends from Claim 1, the Examiner repeats his unsupported legal theory for ignoring claim recitations and focuses on an alleged concept rather than express claim recitations.

He also repeatedly relies upon a straw-man argument that “KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness” to support his rejection of dependent claims. As discussed earlier, the Appeal Brief does *NOT* argue a requirement for “a specific teaching, suggestion, or motivation”. In comparison, the Appeal Brief argues that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as provided in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006).

The Examiner equates “a specific teaching, suggestion, or motivation” with the requirement for “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” and essentially admits that many of his rejections are conclusory statements without “some rational underpinning to support the legal conclusion of obviousness” and often fails to provide any explanation as to how the cited prior art meets the recitations of the claims. For example, see the rejection of Claims 6, 10-12, and 25.

“[T]he question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP 2141.02(I), citing Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) and Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir.

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1983) (emphasis in original). The Examiner ignores the requirement for considering the claimed invention as a whole, and instead focuses on whether the differences would have been obvious. That is why so many of his rejections are conclusory statements devoid of “some rational underpinning to support the legal conclusion of obviousness”. His only reasoning for many of the asserted combinations is because a particular feature is recited in a claim. In other words, he is using improper hindsight reasoning because it is based upon “knowledge gleaned only from the applicant’s disclosure”. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). It is the “invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. 103.” In re Antonie, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977) (emphasis in original) (citations omitted).

Moreover, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” MPEP 214102(VI) (emphasis in original), citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Examiner has never addressed the disclosure in one of the primary cited references, Ross, teaching away from the claimed invention. Specifically, Ross teaches that “passengers on an aircraft are items to be delivered to recipients (i.e., persons meeting the passenger at the airport” (Ross, Col. 7, 24-27). Thus, Ross does not contemplate that deliveries, i.e., service would ever be made to recipients on a transport vehicle and therefore teaches away from the claimed invention. As discussed in MPEP 2144.05(III), “A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” (emphasis in original), citing In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

After nearly eight years of pendency and six office actions of which half cite new grounds of rejections, it is astonishing that the Examiner cannot cite a prior art combination meeting all of the recitations of any of the claims, without relying upon some unsupported

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legal theory for ignoring claim recitations. As noted in the Appeal Brief, "[i]t is as if the Examiner decided in advance that all claims would be rejected and would repeatedly search for prior art in response to Applicant's replies until either the Examiner found something supporting his rejections or the Applicant was worn down and abandoned the application."

The Board is accordingly requested to reverse the Examiner's rejection of all of the currently pending claims. As has been shown, the record is replete with examination errors, such as impermissibly distilling the invention down to a "concept," lack of articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, citation to portions of prior art that do not disclose what the Examiner alleges, citation of prior art with no explanation as to how that art meets the recitations of the claim against which the art has been cited, hindsight bias, claim construction that is not consistent with the specification, and recitations that have been ignored in the claims based upon an unsupported legal theory. Even under the standards set forth in this unsupported legal theory, the claim recitations cannot be ignored.

For these reasons, it is submitted that the Examiner has not established a prima facie case of obviousness for any of the claims, and that even if a prima facie case of obviousness has been established, it has been rebutted. Accordingly, the Board is requested to expeditiously reverse all of the rejections.

Respectfully submitted,



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